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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,206	02/10/2005	Pascale Lacan	ESSR-091US	9943
33425 7590 04/03/2008 FULBRIGHT & JAWORSKI L.L.P. 600 CONGRESS AVE. SUITE 2400 AUSTIN, TX 78701				
EXAMINER				
BASHORE, ALAIN L				
ART UNIT		PAPER NUMBER		
1792				
MAIL DATE		DELIVERY MODE		
04/03/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/524,206

Applicant(s)

LACAN ET AL.

Examiner

Alain L. Bashore

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-71 is/are pending in the application.
- 4a) Of the above claim(s) 62-71 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/CI/CDC)
- Paper No(s)/Mail Date 1-11-08; 1-29-08
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. The election with traversal of claims 28-61 is hereby acknowledged. The previous restriction requirement is withdrawn as applicant's arguments are persuasive regarding the argument of: no commonly shared technical feature. A new restriction requirement under 35 USC 121 and 372 is hereby made below with prior art to show no special technical feature present. The special technical feature is described by applicant in the previous response to a restriction requirement dated 6-13-07. The new restriction requirement given below is not made final, but the invention has been constructively elected by original presentation for prosecution on the merits regarding method claims only.

2. Claims 62-71 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 6-13-07. A claims set must reflect the withdrawn status of claims 62-71 or the response will be considered non-responsive.

3. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 28-62, drawn to method.

Group II, claim(s) 62-71, drawn to article.

4. The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The references to Singh et al in view of Kondo et al further view of Medwick et al disclose: forming a non-fluorinated metallic oxide and/or a hydroxide layer on a MgF₂ temporary protective layer, the temporary layer being coated on an organic or mineral external layer of an ophthalmic lens. The reasons for combining the two references are given in the 35 USC 103 rejection below. The special technical feature is identified by applicant in the previous response to a restriction requirement dated 6-13-07.

5. The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Specification

6. The disclosure is objected to because of the following informalities: No sections indicating background, summary, brief description of the drawings, or detailed description are present.

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.

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- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

Appropriate correction is required.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 28-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over [Singh et al ('358) and Weinrich (921)] in view of Kondo et al (787) further view of [Medwick et al ('773) and the admitted prior art].

Singh et al discloses a deposit of at least one non-fluorinated metallic oxide and/or of at least one non fluorinated metallic hydroxide on a magnesium fluoride protective layer (col 3, lines 3-29).

Weineich discloses a liquid phase chemical treatment of magnesium fluoride layer, leading to the formation of MgO and/or Mg(OH)₂ in and/or on the magnesium fluoride layer (col 1, lines 1-31; col 3, lines 17-38 and 70-75).

Singh et al and Weineich do not disclose:

the MgF_2 layer as a temporary protective layer;

the metal oxide as of magnesium; and,

an organic or mineral external layer, as hydrophobic and/or oilophobic surface further with thickness ranges as recited by applicant.

Kondo et al discloses a method for treating an ophthalmic lens comprising two main sides, wherein at least one side comprises an organic or mineral external layer . Also disclosed is the external layer as hydrophobic and/or oilophobic surface and thickness ranges (col 1, lines 16-33; col 6, lines 5-10).

It would have been obvious to one with ordinary skill in the art to include an organic or mineral external layer, and with the thickness ranges as claimed because the admitted prior art discloses organic or mineral external layers modifying the surface energy for anti-stain hydrophobic and/or oilophobic coatings.

Medwick discloses that a temporary or removable protective film or coating 16 may be provided over at least a portion of a glass substrate 12 (See column 7, lines 9-12) of any composition having any properties (See column 5, lines 9-17) having one or more "non-removable" functional coatings 14 such as metal oxide coating, a non-metal oxide coating, or a multiple layer coating (See column 6, lines 33-35) including one or

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more anti-reflective metal oxide coatings (See column 6, lines 42- 43) to inhibit or prevent chemical and/or mechanical damage to the surface of the substrates 12 or functional coatings 14. The protective coating 16 may be subsequently removed and does not easily scratch or damage the underlying substrate 12 or optional functional coating 14 (See column 7, lines 12-17).

It would have been obvious to one of ordinary skill in the art to have made the MgF₂ layer as a temporary protective layer with the expectation of providing the desired protection of the hydrophobic and/or oil-repellent anti-stain surface coatings on the ophthalmic glasses during trimming, as taught by Medwick et al.

Medwick discloses different metal oxides (col 6, lines 42-43).

It would have been obvious to one with ordinary skill in the art to magnesium as the metal for the oxide thereof because Medwick teaches as desirable the metallic oxide has transparent or substantially transparent to visible light as a property (col 6, lines 46).

Regarding a specific claimed parameter not explicitly disclosed, it would have been obvious to one with ordinary skill in art to combine for the purposes of routine experimentation, in absence of criticality of result.

Regarding the use of water or soda, and the subsequent drying thereafter, as claimed in claims 36-56, it would have been obvious to one with ordinary skill in the art because Singh et al teaches cleaning before treatment (col 3, lines 55-61). Regarding temperatures, contact times, and concentrations, such would be obvious to one with ordinary skill in the art as routine experimentation for the purpose of cleaning parameters required, in absence of unexpected or unobvious results.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alain L. Bashore whose telephone number is 571-272-6739. The examiner can normally be reached on about 7:30 am to 5:00 pm (Mon. thru Thurs.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alain L. Bashore/
Primary Examiner, Art Unit 1792